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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/804,034  | 03/19/2004  | Paul Lapstun         | NPA136US                    | 7056                   |
| 24011 7590 01/08/2008<br>SILVERBROOK RESEARCH PTY LTD<br>393 DARLING STREET<br>BALMAIN, 2041<br>AUSTRALIA |             |                      | EXAMINER<br>PHAM, THIERRY L |                        |
|   |             |                      | ART UNIT<br>2625            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>01/08/2008     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/804,034

**Applicant(s)**

LAPSTUN ET AL.

**Examiner**

Thierry L. Pham

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 10/19/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/5/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed 10/19/07.
- Claims 1-9 are currently pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/07 has been entered.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 9/5/07 was filed after the mailing date of the final rejection on 8/21/07. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti et al (US 5754308), and in view of Winter et al (US 200100406850).

Regarding claim 1, Lopresti discloses a copier (*copier 30, fig. 2*) including:

- a scanner (*copier 30 includes a scanner for scanning and decoding the DocID located on the document to be reproduced, fig. 2, col. 4, lines 6-8*) for scanning a surface of a document, the document having document content, first coded data (*DocID 37, fig. 2*) indicative of an identity of the document (*DocID 37 identifies document data along with other parameters, col. 4, lines 13-27 and col. 5, lines 12-26*) assigned and stored by a computer system (*DocIDs are assigned and stored by archive server 32, fig. 2, col. 7, lines 35 to col. 8, lines 23*) networked with the copier (*archive server 32 is networked with copier 30, fig. 2*);
- a detector (*copier 30 includes a detector for detecting and decoding DocID, fig. 5, col. 4, lines 14-35*) arranged to detect the first coded data as the scanner scans the surface of the document so as access a digital version (*retrieving digital representation of the document content via using decoded DocID, wherein digital representation is stored in remote archive server 32, fig. 2, col. 4, lines 14-49*) of the document identified by the first coded data stored by the computer system (*col. 8, lines 14-26*); and
- a printer (*copier machine as shown in fig. 3 includes a print engine for outputting scanned data onto the print media, fig. 3 & 5, col. 8, lines 8-10*) adapted for printing a copy of the digital version of the scanned document and for incorporating (*printing/copying a "scanned" document along with newly DocID, col. 7, lines 35 to col. 8, lines 13*) in said printed copy, in accordance with said user request (*user request as shown in fig. 5*), document content (*document content, col. 7, lines 40-42*) and second coded data indicative (*new and/or secondary DocID issued by archive server for identifying the document contents, person who generated the page, input location, input parameters, and etc, col. 8, lines 14-23*) of an identity of the copy assigned and stored by the computer system (*DocIDs are assigned and stored by archive server 32, fig. 2, col. 7, lines 35 to col. 8, lines 23*).

However, Lopresti fails to teach and/or suggest a scanner for scanning a surface of a document having a user input marked on the surface of the document in order to access a digital version of the document.

Winter, in the same field of endeavor for printing and retrieving document data from remote device, teaches a well-known example of an image forming apparatus having a scanner (*scanner 46, fig. 2*) for scanning a surface of a document (*proof sheet containing user input*

***marked on a proof sheet, figs. 3-6, par. 9) having a user input marked on the surface of the document in order to access digital version of the document (scan the proof sheet to access the stored images for printing, fig. 7, pars. 9-10). Notes: Winter also teaches first and second identity marker 60 and 62 for identifying image contents.***

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify copier of Lopresti that allows the scanner unit to scan a surface of a document having a user input marked on the surface of the document in order to access the digital version of the document as taught by Winter (1) to ensure that the correct picture is being retrieved/selected for printing via using user input marked on the surface of the document; (2) allows operators/users to designate print size, quantity, brightness, and etc (see fig. 4 of Winter) via using user's input marked on a document's surface that enables the retrieved documents (e.g. as taught by Lopresti via using DocID) to directly print using the designated parameters without having to re-enter the parameters (e.g. size, quantity) after the image is being retrieved; (3) additional advantage of using user's marked input on a document's surface for retrieving the document data prevents the system from printing images and/or user designated enhancements from reinserted form that do not correspond to the digital images currently available (par. 29).

Therefore, it would have been obvious to combine Lopresti with Winter to obtain the invention as specified in claim 1.

Regarding claim 2, Lopresti further discloses a copier according to claim 1 further including a network interface (network interface, fig. 2) for transmitting to a computer system (archive server 32, fig. 2) data indicative of said first coded data and for receiving from said computer system response data indicative of an identity of the copy (col. 4, lines 14-49).

Regarding claim 3, Lopresti further discloses a copier according to claim 2 further including a coded data generator (DocID can be generated either at archive server or at the copier machine, col. 8, lines 1-26) adapted to generate said second coded data from said response data.

Regarding claim 4, Lopresti further discloses a copier according to claim 1 wherein said copier is adapted to communicate with a server (copier machine 30 is communicated with archive server 32, fig. 2) for allocating a unique identifier (fig. 4) to each copy.

Regarding claim 5, Lopresti further discloses a copier according to claim 4 wherein data indicative of said unique identifier (identifier, col. 8, lines 14-26) is incorporated into said second coded data (new DocID or "banks" of DocIDs, col. 8, lines 14-26) and is printed in said printed copy.

Regarding claim 7, Lopresti further discloses a copier according to claim 2 further adapted to transmit through said network interface (network as shown in fig. 2) second document data representing said copy of the document to enable said second document data to be stored.

Regarding claim 8, Lopresti further discloses a copier according to claim 7 wherein said second document data can be retrieved through said network interface (document retrieved network interface, fig. 4) to enable reproduction of said copy with both document content and coded data.

Regarding claim 9, Lopresti further discloses a copier according to claim 1, wherein the printer is further adapted to incorporate (printing/copying a "scanned" document along with newly DocID, col. 7, lines 35 to col. 8, line 13) in said printed copy portions of said document content as scanned by the scanner not contained (newly DocID not previously in digital version of document, col. 7, lines 35 to col. 8, line 13) in said digital version of the document in accordance with said user request (user request, fig. 5) determined from the scanned user input.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti and Winter as described in claim 1 above, and further in view of Dymetman et al (US 6330976).

Regarding claim 6, Lopresti teaches a second coded data indicative of an identity of the copy, but fail to teach and/or suggest wherein a second coded data device is indicative of a

plurality of reference points on a printed copy to identify the position of the sensing device relative to the copy.

Dymetman, in the same field of endeavor for printing, teaches a second coded data indicative of an identity of the copy, but fails to teach and/or suggest wherein a second coded data device (col. 3, lines 50-67 and col. 9, lines 15-21) is indicative of a plurality of reference points on a printed copy to identify the position (location identifier coded data for identifying location of a photograph, zone, and etc within a document, col. 3, lines 58-67 and col. 8, lines 60-67) of the sensing device relative to the copy.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Lopresti invention to include coded data identifying a position of the sensing device relative to the copy as taught by Dymetman because of a following reason: (●) adding a location identifier coded data to identify the position of the sensing device relative to the copy helps user to easily locate the location of the tags.

Therefore, it would have been obvious to combine Lopresti, and Winter with Dymetman to obtain the invention as specified in claim 6.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

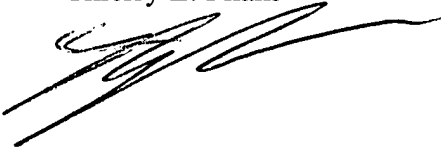
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Thierry L. Pham

A handwritten signature in black ink, appearing to be 'Thierry L. Pham', written over a horizontal line.